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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/234,253	01/20/1999	RAYMOND SELTZER	A-21835/P2/C	6356

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EXAMINER

ALVO, MARC S

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/234,253

Applicant(s)

SELTZER ET AL.

Examiner

Steve Alvo

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40, 44 and 45 is/are pending in the application.
- 4a) Of the above claim(s) 12-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 35-40 and 44 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Claims 1-11, 35-40 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over SELTZER et al in view of RODGERS et al.

SELTZER et al teaches adding mixtures of UV absorbers and light stabilizing agents, including N,N-diethylhydroxylamine (column 11, line 35 and column 12, line 66), to polymer coating compositions including polyurethane (column 8, line 12) and polyesters (column 8, line 30). RODGERS et al teaches polyurethane and polyester coating compositions containing UV absorbers, including benzotriazoles (column 5, line 28 and Example 1), can be used to coat paper and textiles to prevent fading of dyes (column 1, lines 35-40 and abstract). It would have been obvious to the routineer that the polyesters and polyurethanes of SELTZER et al which contain UV absorbers can be used to coat paper and textiles to prevent fading of dyes, e.g. reducing the loss of brightness, in the manner taught by RODGERS et al. SELTZER et al teaches that benzotriazoles are of particular value as the UV absorber. RODGERS et al teaches that 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) can be used as the benzotriazol UV absorber (Example 21, see Table, column 13). It would have been prima facie obvious to use the 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) as the benzotriazol of SELTZER et al as they perform the same function of UV absorption. The claimed N,N-diethylhydroxylammonium citrate would be a salt of and an obvious variant of the genus N,N-hydroxylamine. It would have been obvious to combine the teachings of SELTZER with that of RODGERS to obtain the benefits of both preventing fading and increasing brightness. Besides, the claims drawn to a composition and not to the use of the composition. As set forth above, It would have been obvious to the routineer that the polyesters and polyurethanes of SELTZER et

al which contain UV absorbers can be used to coat paper and textiles to prevent fading of dyes in the manner taught by RODGERS et al.

The arguments, including the Declaration of Mr. David Vidal, have been considered but are not convincing as RODGERS et al teaches that the composition can be used to coat paper. RODGERS et al teaches, column 8, lines 35-38, "for paper, addition to wet pulp, but here also, surface application by a spraying or a coating process is preferable. It is possible to mix the inventive UV-absorbing polymers with other finishing agents for paper". Besides the claims are drawn to a composition. The use of the composition, e.g. to brighten paper, cannot be given probative weight in a product claim. SELTZER teaches using both light absorbers and light stabilizing agents. It would have been obvious to use the UV absorber of RODGERS for the UV absorber of SELTZER. RODGERS et al teaches that 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) can be used as the benzotriazol UV absorber (Example 21, see Table, column 13). It would have been prima facie obvious to use the 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) as the benzotriazol of SELTZER et al as they perform the same function of UV absorption. It would have been prima facie obvious to substitute one known UV-absorber for another.

Claim 45 has not been rejected over the art as it would not have been obvious to use the specific 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt with the citrate salt of tris(N,N-diethylhydroxylammonium) of SELTZER.

Claim 45 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if proper terminal disclaimers are filed.

This election of species requirement was made Final in Paper No. 9. Applicant elected within the method claims (1-43) the following species: N,N-diethylhydroxylamine or its salt (see Office Action mailed 8-1-2000) as the hydroxylamine and 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) as the stabilizer. Withdrawn claims 12-34 contain non-elected species.

The arguments that polyurethane and polyester coatings are unknown as paper coatings, including the Declaration of Mr. David Vidal, are not convincing as RODGERS et al teaches that the composition can be used to coat paper. RODGERS et al teaches, column 8, lines 35-38, "for paper, addition to wet pulp, but here also, surface application by a spraying or a coating process is preferable. It is possible to mix the inventive UV-absorbing polymers with other finishing agents for paper". SELTZER teaches using both light absorbers and light stabilizing agents. It would have been obvious to use the UV absorber of RODGERS for the UV absorber of SELTZER. RODGERS et al teaches that 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) can be used as the benzotriazol UV absorber (Example 21, see Table, column 13). It would have been prima facie obvious to use the 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) as the benzotriazol of SELTZER et al as they perform the same function of UV absorption. It would have been prima facie obvious to substitute one known UV-absorber for another. Both SELTZER et al and RODGERS et al solve the problem of the degradative effect of light ion paper coatings. Obviously when the coatings are used on paper as taught by RODGERS et al, the coatings of SELTZER et al would further prevent the loss of brightness

(SELTZER et al, column 13, line 49-50) and enhance resistance to yellowing (column 13, lines 29-32) to the coated paper.

It is noted that the instant Application also discloses that “the stabilizer and/or coadditives may be formulated into a paper sizing or coating composition” (instant specification, page 11, last paragraph, last sentence). Thus the instant composition for preventing the loss of brightness and for enhancing resistance to yellowing of pulp or paper can be a coating composition. This is substantially the same way that SELTZER et al and/or RODGERS et al prevent degradation due to the effect of light. Thus the problem solved by Applicant would have been obvious from the combined teachings of SELTZER et al and RODGERS et al. The problem of enhancing the resistance to yellowing is a problem of the coating and not of the substance to which it is applied.

The elected species is “CIBAFast®W”. This is the same benzotriazole used in Example 21 of RODGERS et al. Although Applicant argues that the “CIBAFast®W” of Example 21 is an ineffective stabilizer, it actually is a better UV absorber than the other benzotriazole UV absorber (LS008). It would have been prima facie obvious to substitute the better UV absorber benzotriazole (“CIBAFast®W”) for the other benzotriazole of SELTZER et al. Besides non-preferred embodiments or disclosures as being unsatisfactory for intended use can be the foundations for holdings of obviousness, *In re Boe*, 148 USPQ 507; *In re Lamberti*, 192 USPQ 278; *In re Burckel*, 201 USPQ 70.

The argument that SELTZER et al teaches using many different coating compositions is not convincing as SELTZER et al is using (Example 21) polyurethane and “CIBAFast®W”. This is the same type of compound used by Appellant. It would have been obvious from the teachings

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of ROGERS et al to use "CIBAFast®W" with the polyurethane coating disclosed by SELTZER et al to prevent yellowing and prevent light degradation.


**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Alvo whose telephone number is 703-308-2048. The examiner can normally be reached on 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 703-308-3837. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
**STEVE ALVO**  
**PRIMARY EXAMINER**

msA  
12-1-03